



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,924	05/04/2001	Fred E. Regnier	290.0001 0101	8955

26813 7590 05/07/2002

MUETING, RAASCH & GEBHARDT, P.A.  
P.O. BOX 581415  
MINNEAPOLIS, MN 55458

EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
----------	--------------

1641

DATE MAILED: 05/07/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/849,924

Applicant(s)

REGNIER ET AL.

Examiner

My-Chau T. Tran

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 1/31/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-99 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-99 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-32, drawn to a method for detecting a difference in the concentration of a protein, classified in class 436, subclass 57.
  - II. Claim 33, drawn to a method of detecting a difference in the concentration of a protein with a capture moiety, classified in class 436, subclass 151.
  - III. Claim 34, drawn to a method for determining whether a protein is present in one sample but not in another sample, classified in class 435, subclass 4.
  - IV. Claims 35-58, drawn to a method for analyzing differences in protein content among plural protein samples, classified in class 435, subclass 7.1.
  - V. Claims 59-61, drawn to a method for quantifying a peptide, classified in class 436, subclass 149.
  - VI. Claims 63-83, drawn to a method for identifying a protein with affinity ligand, classified in class 435, subclass 287.1.
  - VII. Claim 84, drawn to a method for identifying a protein with a signature peptide, classified in class 436, subclass 173.
  - VIII. Claims 85-99, drawn to a method for analyzing a protein, classified in class 435, subclass 287.2.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I-VII are unrelated and independent inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions as claimed have different method steps that required different components and modes of operation. The method step of covalently attaching an isotopic variant of Group I is not required by the claims of Groups II-VIII. The method step of contacting peptides with a capture moiety to select a pair of chemically equivalent isotopically distinct peptides of Group II is not required by the claims of Groups I and III-VIII. The method step of partitioning the sample into subsample of Group III is not required by the claims of Groups I-II and IV-VIII. The method step of analyzing the affinity-selected peptides by mass spectrometry of Group IV is not required by the claims of Groups I-III and V-VIII. The method step of determining the isotope ratio of two fragment ions of Group V is not required by the claims of Groups I-IV and VI-VIII. The method step in which the protein to be identified includes an affinity ligand of Group VI is not required by the claims of Groups I-V and VII-VIII. The method step of using the mass of the signature peptide to identify the protein of Group VII is not required by the claims of Groups I-VI and VIII. The method step of analyzing a portion of the peptide pool in which the affinity ligand does not include an isotopic label of Group VIII is not required by the claims of Groups I-VII.

3. Because these inventions are distinct for the reasons given above and the searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. Additionally, different patentability considerations are involved

Art Unit: 1641

for each group. For example, a patentability determination for Group III would involve a determination of the patentability of the method for determining whether a protein is present in one sample but not in another sample while a patentability determination for Group V would involve a consideration of the patentability of the method for quantifying a peptide. These considerations are very different in nature.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on 703-305-3399. The fax phone numbers for the

Application/Control Number: 09/849,924

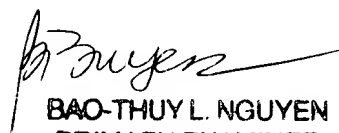
Page 5

Art Unit: 1641

organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

mct  
May 1, 2002

  
BAO-THUY L. NGUYEN  
PRIMARY EXAMINER  
5/3/02